

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-23 are presently active in this case. The present Amendment amends Claims 11 and 15 without introducing any new matter.

Claims 15-21 were rejected under 35 U.S.C. §102(b) as anticipated by Morales et al. (U.S. Patent No. 4,847,837, herein "Morales"). Claim 22 was rejected under 35 U.S.C. §103(a) as unpatentable over Morales in view of Adams (U.S. Patent No. 5,142,532). Claim 23 was rejected under 35 U.S.C. §103(a) as unpatentable over Morales in view of Suzuki (U.S. Patent No. 4,884,263).

Claims 1-14 were allowed. Applicants acknowledge with appreciation the indication of allowed subject matter.

To clarify claimed features and to correct minor formalities, Claim 15 is amended. In particular, Claim 15 is amended to recite "wherein the interface device of each station is linked to a first splitting device and to a second splitting device via an interface device of at least one additional station." This feature finds non-limiting support in the disclosure as originally filed, for example from page 6, line 35 to page 7, line 10 and in corresponding Figure 1. Further, Claim 11 is amended to correct minor formalities.

In response to the rejection of Claims 15-21 under 35 U.S.C. §102(b) over Morales, Applicants respectfully request reconsideration of this rejection and traverse the rejection, as discussed next.

Briefly recapitulating, Claim 15 relates to a network for distributing information between a central unit and stations. The network includes information splitting devices with inputs/outputs that are connected to the central unit and to the stations, wherein each station includes an interface device. Further, the interface device of each station is linked to a first

splitting device and to a second splitting device via an interface device of at least one additional station, and the plural interface devices are mounted in cascade on a link starting from a splitting device.

As explained in Applicants' Specification from page 3, line 13 to page 4, line 2, the network of Claim 15 improves upon background networks for distributing information, because stations can be supplied with information from two different influxes to create redundancy of information transmission.

Turning now to the applied reference, Morales discloses an error-detecting and error-correcting local area networked computer system, wherein an interfacing transceiver 18 attached to networks 12 and 14 is connected to a plurality of nodes 16.¹ Switches 34 with two outputs 36 and 38 are located between the nodes 16 and the interfacing transceivers 18 to connect or disconnect the nodes to the networks 12 and 14.² However, Morales fails to teach an interface device linked to a first splitting device and to a second splitting device via an interface device of at least one additional station. On the contrary, Morales explicitly teaches "each switch 34 has one bidirectional output 36 connected to a interfacing transceiver 18 on LAN1 12 and a second output 38 connected to a interfacing transceiver 18 on LAN2 14."³ Further, Morales states that each workstation has a pair of interface boards 20, 22 for connecting to respective ones of the LAN cables 12, 14.⁴ A workstation having a pair of interface boards for connecting to respective LAN cables, as taught by Morales, *is not* an interface device linked to a first splitting device and to a second splitting device *via an interface device of at least one additional station*, as claimed.

Therefore, Morales fails to teach or suggest every feature recited in Claims 19-21, so that Claims 15-21 are believed to be patentably distinct over Morales. Accordingly,

¹ See Morales in the Abstract.

² See Morales at column 4, lines 51-67 and in corresponding Figure 2.

³ See Morales at column 4, lines 51-54.

⁴ See Morales at column 2, lines 49-51.

Applicants respectfully traverse, and request reconsideration of, the rejection based on Morales.⁵

The references Adams and Suzuki do not remedy the deficiencies of Morales, since both references also do not teach or suggest the claimed an interface device linked to a first splitting device and to a second splitting device via an interface device of at least one additional station. Adams discloses an optical telecommunication system to provide telephony and broadcast TV transmitted with different wavelengths via optical fibers to customers' premises⁶, and Suzuki discloses packet-switched communications network in which each of a plurality of terminals sequentially transmits control packets in response to a request for call before sequentially transmitting message packets.⁷ However, both references Adams as well as Suzuki do not teach or suggest an interface device linked to a first splitting device and to a second splitting device via an interface device of at least one additional station. Therefore, even if the combination of Morales with Adams and/or Suzuki is assumed to be proper, the combination fails to teach every element of the claimed invention. Accordingly, Applicants respectfully traverse, and request reconsideration of the rejections of Claims 22 and 23 under 35 U.S.C. §103(a) based on these references.⁸

Further, Applicants respectfully traverse the obviousness-type rejection of Claim 22 based on Morales and Adams because there is insufficient evidence for a motivation to modify the Morales' redundant error-detecting and error-correcting local area networked

⁵ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also-MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

⁶ See Adams in the Abstract.

⁷ See Suzuki in the Abstract.

⁸ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

computer system by incorporating Adams' passive optical splitters to deliver telephony and broadcast TV, for the following reasons.⁹

The outstanding Office Action states that the proposed modification would have been obvious "to employ a splitting device as taught by Adams in Morales's system for operating at a greater than a nominal bit rate."¹⁰ The record, however, fails to provide the required *evidence* of a motivation for a person of ordinary skill in the art to perform such modification. While Adams may provide a reason for using passive optical splitters in an optical network for transmitting telephony and broadcast TV with two different optical wavelengths,¹¹ Adams fails to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in a networked computer system with interfacing transceivers to access LAN networks,¹² such as the one disclosed in Morales. In particular, Adams uses the passive optical splitters to split up an optical fiber to serve multiple customers with telephony and broadcast TV without using separate wavelengths for each customer. Adams, however, does not suggest that optical splitters would work in a redundant local area networked computer system, much less for interfacing transceivers for LAN networks.¹³ Adams does not state that interfacing transceivers for LAN networks of Morales need "a splitting device."

Morales and Adams, therefore, do not provide the motivation to perform the proposed modification of Morales' networked computers. In other words, an attempt to bring in the isolated teaching of Adams' optical splitters into Morales would amount to improperly

⁹ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

¹⁰ See outstanding Office Action at page 3, lines 19-20.

¹¹ See Adams at column 2, lines 5-20 and in corresponding Figure 1.

¹² See Morales at column 2, lines 44-58 and in corresponding Figure 1.

¹³ See Morales at column 2, lines 44-49.

picking and choosing features from different references without regard to the teachings of the references as a whole.¹⁴ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.¹⁵ In this case, the record fails to support the proposed modification of Morales.

Furthermore, it is not clear from the record how Adams' optical splitters could be incorporated into Morales. Under such a modification, the passive optical splitters would have to be integrated into a LAN interface transceiver. Such modification would require a substantial reconstruction or redesign of the elements of Morales, and/or would change the basic principle of operation of Morales. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.¹⁶ Furthermore, it is not clear from the record whether such modification would actually provide higher capacities of information that can be delivered to customers.¹⁷

In rejecting a claim under 35 U.S.C. §103(a), the U.S.P.T.O. must support its rejection by "substantial evidence" within the record,¹⁸ and by "clear and particular" evidence¹⁹ of a

¹⁴ See In re Ehrreich, 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

¹⁵ See In re Lee, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

¹⁶ See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

¹⁷ See outstanding Office Action at page 3, 21-22.

¹⁸ See In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

¹⁹ See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources

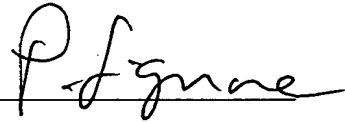
suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying Morales by incorporating Adams' passive optical splitters. Without such motivation and absent improper hindsight reconstruction,²⁰ a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claim 22 is believed to be non-obvious and patentable over the applied references.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-23 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

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available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." (emphasis added).

²⁰ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."